

DETAILED ACTION

It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Application number (checked for accuracy, including series code and serial no.).
2. Group art unit number (copied from most recent Office communication).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.
6. Confirmation number (See MPEP § 503).

Response to Arguments

1. Applicant's amendments have overcome the prior art of record. However, upon further review, there are issues with the claims, as discussed with the applicant on 1/15/2010, which need to be addressed (see below) before allowance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 29 through 32, and 56 through 59 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no structure defined which would enable one of ordinary skill to use to construct the means for as recited in the claims.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29 through 32 and 56 through 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite a means for the coder but the claims do not recite the structure necessary for performing the steps indicated.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 through 27, 36, and 41 through 55 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. The Federal Circuit¹, relying upon Supreme Court precedent², has indicated that a statutory “process” under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the “machine or transformation test”, whereby the recitation³ of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See *Benson*, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See *Flook*, 437 U.S. at 590”). While the instant claim(s) recite a series of steps or acts to be

¹ *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

² *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

performed, the claim(s) neither transform an article nor are positively tied to a particular machine that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

That is, there is no particular machine required for the steps, thus failing the machine test, and there is no external depiction of the data, thus failing the transformation test, rendering the claims non-statutory.

7. Claims 33 and 56 through 59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The specification does not provide what the codec is. Using the plain language meaning, a codec can be purely software or hardware, but since no clear definition is made, a purely software version (signals, due to the fact that the specification defines software to reside on a machine-readable carrier), is considered non-statutory.

8. Claims 34, 60, and 62 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program is interpreted as resided on a machine-readable data carrier (signals, see page 7, lines 5-7), and therefore the carrier is a signal, which is non-statutory.

Claims 35, 61, and 63 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The machine readable data carrier carries signals which is non-statutory.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirav G. Patel whose telephone number is (571)270-5812. The examiner can normally be reached on Monday - Friday 8 am - 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nirav G. Patel/
Examiner, Art Unit 2624

/CHARLES KIM/
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